

REMARKS

Claims 7-13 and 18-28 are pending in this application.

Applicant has amended claim 18, has canceled claims 1-6 and 14-17, and has added new claims 23-28. These changes do not introduce any new matter.

In response to the Examiner's request, Applicant has amended the specification to insert the missing application number for related U.S. Application No. 10/633,108.

Applicant respectfully requests reconsideration of the rejection of claims 14-22 under 35 U.S.C. § 101 as being directed toward non-statutory subject matter. As noted above, Applicant has herein canceled claims 14-17. Applicant has amended independent claim 18 to comply with the Patent Office's policy regarding 35 U.S.C. § 101. Accordingly, Applicant submits that claims 18-22 now define statutory subject matter under 35 U.S.C. § 101, and requests that the rejection of these claims thereunder be withdrawn.

Applicant respectfully requests reconsideration of the rejection of claims 1-22 under 35 U.S.C. § 103(a) as being unpatentable over *Dwyer, III et al.* ("*Dwyer*") (U.S. Patent No. 5,727,167) in view of *Benitez et al.* ("*Benitez*") (U.S. Patent No. US 6,189,141 B1). As noted above, Applicant has herein canceled claims 1-6 and 14-17. As will be explained in more detail below, the combination of *Dwyer* in view of *Benitez* does not raise a *prima facie* case of obviousness against independent claims 7 and 18.

Independent claim 7 defines a method for executing an optimized version of a program. In this method, when an interrupt is received during the execution of the optimized version of the program and execution control is returned to an operating system, an original version of the program is executed. During execution of the original version of the program, a hardware performance counter is monitored. When the hardware performance counter reaches a threshold, execution control is switched to a dynamic optimizer, to continue the executing of the optimized version of the program as directed by the dynamic optimizer.

The *Dwyer* reference discloses a thresholding mechanism and method for performance monitoring of memory array access distribution times. The *Benitez* reference discloses “a system, method, and product for continuous path evaluation at run time in order to identify and evaluate hot traces.” Column 2, lines 35-37. The “hot traces” identified in the *Benitez* reference are blocks of original instructions of an executable file through which control frequently passes.

Applicant respectfully submits that the combination of *Dwyer* in view of *Benitez* fails to raise a *prima facie* case of obviousness against the subject matter defined in claim 7 for at least two reasons. First, the requisite suggestion or motivation to combine the references is lacking. The identification and evaluation of “hot traces” shown by *Benitez* is generally related to the optimization of software, but is not related to the specific problem addressed in the *Dwyer* reference, namely the providing of “detailed information on the distribution of access times while accessing all levels of a system’s memory hierarchy during an application’s execution.” Column 2, lines 15-17. Thus, Applicant submits that one having ordinary skill in the art would not have been motivated to combine the *Dwyer* and *Benitez* references in the manner proposed by the Examiner.

Second, even if the *Dwyer* and *Benitez* references were to be combined in the manner proposed by the Examiner, the result of the combination would not have been the method defined in claim 7. Neither the *Dwyer* reference nor the *Benitez* reference involves the situation specified in claim 7. In particular, neither the *Dwyer* reference nor the *Benitez* reference involves a situation in which an optimized version of a program is being executed and an interrupt is received during the execution of the optimized version of the program, with the interrupt returning execution control to an operating system. As such, even if the “hot trace” identification technique of *Benitez* were to be incorporated into the method for performance monitoring of memory array access distribution times of *Dwyer*, the result of

this combination would not include each and every method operation specified in claim 7. In this regard, Applicant notes that the Examiner's statement of the rejection of claim 7 merely states "As per claim 1." Office Action at page 4. As claim 1 does not include all of the features specified in claim 7, Applicant respectfully submits that the Examiner's reference to claim 1 is insufficient to establish a *prima facie* case of obviousness against the subject matter defined in claim 7.

Independent claim 18 defines computer readable media encoded with a program that causes a computer to implement the same method operations specified in claim 7. Thus, the arguments set forth above regarding claim 7 apply equally to claim 18.

Accordingly, for at least the foregoing reasons, independent claims 7 and 18 are patentable under 35 U.S.C. § 103(a) over the combination of *Dwyer* in view of *Benitez*. Claims 8-13, each of which depends from claim 7, and claims 19-22, each of which depends from claim 18, are likewise patentable under 35 U.S.C. § 103(a) over the combination of *Dwyer* in view of *Benitez* for at least the same reasons set forth above regarding the applicable independent claim.

As noted above, Applicant has added new claims 23-28. New independent claim 23 defines a method for executing an optimized version of a program that is similar to that defined in claim 7, but that includes more details for some of the method operations than are specified in claim 7. New independent claim 27 defines computer readable media encoded with a program that causes a computer to implement the same method operations specified in claim 23.

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of claims 7-13 and 18-22, as presented herein, and examination of new claims 23-28, and submits that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the

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prosecution of this application, the Examiner may reach the undersigned at (408) 749-6902. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. SUNMP317).

Respectfully submitted,
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A handwritten signature in black ink, appearing to read 'Peter B. Martine', with a large, stylized initial 'P'.

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